

NEIFELD REF: HENN0015UPCT-US

(HENNING REF: 1.159.US1)

(HORMAN REF: 990348

APPLICATION NO: 09/423,275

Filed: 1/27/2000

TITLE: Security element structure for documents, devices for checking documents with such security elements, method of the use thereof

PTO confirmation code: 6553

Sir: Enclosed please find the following document.

**37 CFR 1.137 PETITION TO REVIVE DUE TO UNINTENTIONAL ABANDONMENT**

## **I. Relief Requested**

That applicant requests that this application be revived due to an unintentional abandonment. A check for the \$750 small entity fee for consideration of this petition is enclosed.

## **II. Statement of Material Facts**

On Tuesday, November 22, 2005 5:43 AM, I received an email from German patent attorney Joachim Brunnotte , stating that:

Rick

Another question: Would you be able to handle some existing US applications (list see below) of a new client of our firm, and possibly new cases in the future?

The client is a joint client of another German patent attorney, Martin Hennings, and of our firm. Martin is a friend and is a part time free lance attorney. However, he is a full time patent professional, also working in the patent department of Bombardier Transportation GmbH, Germany.

Martin will handle all prosecution work on his own, except some special cases, for example oppositions and infringement, which are handled jointly by Martin and our firm.

Martin has taken over representation of the client recently. He knows the client from his time as a trainee, some years ago. The attorney who trained Martin is about to retire.

Our joint client is:

WHD elektronische Prueftechnik GmbH, Industriestrasse 19, 01129 Dresden,  
Germany

The main technical field of WHD is verifying authenticity of money (banknotes and coins), or more generally sensors and software for this and similar purposes.

If there is no conflict and if you have time to handle these cases,

please:

- contact Martin to set up the direct relationship
- please perform a preliminary check on the status of the US applications listed below. Our concern is that some of the cases which have been handled by another US attorney (Hormann) are abandoned. The client would like to know if these cases can be revived.

As far as I know, Mr Hormann will retire soon. In any case, the client would not like him to continue as representative.

Best regards,

Joachim

Joachim's email to me included a copy of a prior email to him from email address [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) dated "Dienstag, 22. November 2005 09:23" stating that:

> Dear Achim,  
>  
> as discussed during our recent telephone conversation please find below  
a  
> list of US patent applications by WHD, represented by US attorney Mr  
> Hormann:  
>  
> 08/894,766  
> 09/931,694  
> 09/485,734  
> 09/423,275  
> 10/619,038  
> 09/485,750

> 09/719,881  
> 10/110,600  
> 10/469,795  
> 10/469,652  
> 10/469,794  
>  
> 1. WHD is asking for a proposal for another US Representative. 2.  
> Which of above-mentioned applications are lapsed without  
possibility to  
> re-instate?  
> 3. Which of above-mentioned applications could be re-instated with  
> additional effort? 4. What should be done to enforce claims by WHD  
> against Mr Hormann?  
>  
> Best regards,  
>  
> Martin  
>  
>  
> Dipl.-Ing. Martin Hennings  
> Patentanwalt - European Patent Attorney  
> Fritz-Kühn-Str. 37b  
> D-12526 Berlin  
> Germany  
> Tel.: +49/(0)30/233 67 261  
> Fax: +49/(0)30/233 67 260  
> mob.: +49/(0)179/52 52 588  
> e-mail: martin.hennings@arcor.de

On Tuesday, November 22, 2005 12:16 PM, I sent an email to Joachim and Martin stating that:

Joachim and Martin -

In fact, some of the US patent applications you identified are now abandoned. I have the following information, which I will also use to complete our internal conflict check. Please note that applications unintentionally abandoned are revivable, but there are significant fees, and you must be sure that the abandonment was in fact not intentional on the part of the applicant or their representative. thanks, Rick

Information on published patent applications and some others is publicly available. Information on all other applications remains secret until and unless the application issues. Based upon the information provided by the USPTO, here is the status of the applications in Joachim's email and corresponding application publications.

08/894,766 - not publicly available.

09/931,694 - abandoned; published as US 2001-0054901 A1

09/485,734 - not publicly available.

09/423,275 - abandoned; not published.

10/619,038 - Abandoned; published as US 2004-0012773 A1

09/485,750 - not publicly available.

09/719,881 - not publicly available.

10/110,600 - not publicly available.

10/469,795 - Abandoned; published as US 2004-0101664 A1

10/469,652 - Abandoned; published as US 2004-0096648 A1

10/469,794 - Abandoned; published as US 2004-0105957 A1

Here are the titles and abstract of the publications listed above.

**US 2001-0054901 A1**

Method of testing documents provided with optico-diffractively effective markings

**Abstract**

The invention relates to a method of examining the authenticity of a document provided with an optico-diffractively effective element or hologram by subjecting the hologram to capacitive coupling of a voltage and deriving a signal representative of the voltage for comparison with a reference signal representative of a hologram of an authentic document. The method may be improved by providing, between individual segments of the hologram, additional security indicia providing a signal in response to being irradiated by electromagnetic radiation of a predetermined frequency.

**US 2004-0012773 A1**

Security element structure for documents, devices for checking documents with such security elements, method of the use thereof

**Abstract**

A structure of a security element for documents provided with a combination of differently reacting or responding security features and functional designs, including conductive, magnetic and diffractive ones, which render it difficult or impossible for counterfeiters to discover the functioning of the security element.

**US 2004-0101664 A1**

**Security features**

**Abstract**

The invention relates to security features, preferably tear strips or threads for the identification by the manufacturer or authorized control agents of products. The security features in accordance with the invention are made up of different components, encoding means and electrically conductive layers, whereby they are connected in different arrangements to a support substrate. Layers of known per se electrically conductive polymers are utilized. In accordance with the invention, the security features are tear strips which are connected to a package, for instance by pressing, glueing or sealing. The security features constitute insurmountable technological obstacles for a forger.

US 2004-0096648 A1

Security strips

#### Abstract

The invention relates to security strips for identifying the genuineness of sheet material such as documents, securities and banknotes. The security strips in accordance with the invention are constructed of several different components, encoding means and electrically conductive layers connected in different arrangements on a support substrate. Layers of known per se electrically conductive polymers are being used. The security strips are applied on the sheet material or they are integrated in the sheet material. These security strips constitute insurmountable technological obstacles for a forger.

US 2004-0105957 A1

Security strips

## Abstract

The invention relates to security strips for identifying the genuineness of sheet material such as documents, securities and banknotes. The security strips in accordance with the invention are constructed of several different components, encoding means and electrically conductive layers connected in different arrangements on a support substrate. Layers of known per se electrically conductive polymers are being used. The security strips are applied on the sheet material or they are integrated in the sheet material. These security strips constitute insurmountable technological obstacles for a forger.

On Tuesday 11/22/2005 5:41 PM, I sent an email to Martin Hennings and Joachim Brunnotte's email addresses stating that:

Martin - This email addresses your original questions to Joachim.

You asked about the possibility of reviving abandoned applications. Reviving is only possible if abandonment was unintentional. Moreover, case law indicates that failure to ACT PROMPTLY after recognizing an application or patent has been abandoned can prevent revival. However, since I cannot access the official records for some of the applications identified to me by application number, I cannot advise on those cases the legal criteria applicable for revival. Generally speaking, the revival attempt includes (1) filing a petition to revive an abandoned application (under either the 37 CFR 1.137(a) unavoidable legal standard or the 37 CFR 1.137(b) unintentional legal standard) along with a suitable response to the USPTO paper to which the applicant failed to respond. The "unavoidable" standard must be met in some situations, such as an extended period of abandonment.

It is (from my knowledge of relevant case law and personal experience in

petitioning for revival under this standard) extremely difficult and very very expensive to petition under the "unavoidable" standard. Such a petition requires submission of factual evidence, declarations from fact witnesses, and synthesis of legal argument explaining why the facts show abandonment was "unavoidable" as "unavoidable" is defined by case law.

It is easy to petition for revival under the unintentional legal standard, because all that the petitioner is required to do is assert that the delay was unintentional. However, the assertion must be true, and I must know it to be true to make such a representation. Thus, while the petition under the unintentional standard is far less expensive, it requires an investigation as to the facts surrounding the abandonment. If the conclusion as to whether the abandonment meets the criteria for unintentional abandonment is unclear, then the petition needs to list the facts supporting that conclusion, (1) for me to sign it, and (2) to eviscerate an argument in subsequent litigation that the patent was revived fraudulently.

Since you now know that 6 of the 11 applications are abandoned and you know that I cannot determine whether the other 5 are abandoned, you need to act with all due haste - to take whatever actions are necessary to get to the facts of which applications were unintentionally abandoned, and petition to revive those applications, or decide to forego the attempt to revive.

Enclosed is a form for transferring power of attorney to my firm. However, it is insufficient. It is insufficient because it does not include the proof of ownership by WHD elektronische Prueftechnik GmbH, Industriestrasse 19, 01129 Dresden, Germany of those applications. To prove ownership, you need copies of the proof of recording of the assignments from the inventors to WHD elektronische Prueftechnik GmbH, Industriestrasse 19, 01129 Dresden, Germany in each case, and to provide those to me along with the executed form. You should have received from the prosecuting attorney a "Recordation form cover sheet" with USPTO stamped information on the front listing the "Reel" number

and the "Frame" number. That document, in each application, is what I need to take over prosecution of the applications.

If you do not know status of the applications, once I have power of attorney, I can get copies of the USPTO's official file copies of the currently unavailable applications.

I can at this time obtain copies (or review online) the files of the publicly available applications.

The other alternative is for you to order the existing prosecuting attorney to forward originals or copies of his office files (referred to as attorney files) to me. However, I expect that is either not practical or possible, and I expect those files to be unreliable in any case.

Note: petitions to revive under the unintentional standard noted above would require me to discuss and obtain information from the current prosecuting attorney regarding "intent". I have the following information for this person, based upon the USPTO records. Please advise if it is accurate.

Hormann, Karl

Law Offices Of Karl Hormann

P O Box 381516

86 Sparks St

Cambridge MA US 02238

617-491-8867

26470

Attorney

Your final question was "4. What should be done to enforce claims by WHD against Mr Hormann?"

The answer is manifold. Basically, you can withhold whatever fees you have not yet paid him (at risk of him suing you), sue him for negligence in a U.S. court (at great expense), file a complaint against him with the Office of Enrollment and Discipline, of the USPTO (the patent bar), and file a complaint

with the BAR of any state in which he is registered to practice law. The BAR complaints will not result in monetary recovery. A suit in court would of course require proof of damages, and damages other than my costs in picking up the pieces of the mess, are very difficult to prove for lost otherwise patentable rights. Or, you can charge him privately and obtain a settlement from him privately, but that is also unlikely.

Please let me know if you have further questions. thanks, RICK

On Wednesday 11/23/2005 10:27 AM, I received an email from [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating in part that:

Rick,

thanks for your Emails with the valuable information! I confirm receipt and will contact WHD to discuss the issues.

Regarding my Email addresses please use in future only the following:  
[martin.hennings@arcor.de](mailto:martin.hennings@arcor.de)

Thanks and best regards,

Martin

On Thursday 12/8/2005 10:13 AM, I received an email from [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating that:

Rick,

according to our recent email communication please find attached all available official documents or copies thereof.

Please try to get all necessary information according to all US applications listed in our previous email, especially to those which are not publicly available:

08/894,766 - not publicly available (my ref: 1.099.US) 09/931,694 - abandoned; published as US 2001-0054901 A1 (my ref: 1.157.US) 09/485,734 -

not publicly available (my ref: 1.158.US) 09/423,275 - abandoned; not published (my ref: 1.159.US1) 10/619,038 - abandoned; published as US 2004-0012773 A1 (my ref: 1.159.US2) 09/485,750 - not publicly available (my ref: 1.160.US) 09/719,881 - not publicly available (my ref: 1.197.US) 10/110,600 - not publicly available (my ref: 1.239.US) 10/469,795 - abandoned; published as US 2004-0101664 A1 (my ref: 1.258.US) 10/469,652 - abandoned; published as US 2004-0096648 A1 (my ref: 1.259.US) 10/469,794 - abandoned; published as US 2004-0105957 A1 (my ref: 1.260.US)

From the files I learnt that it was agreed to abandon 10/469,794 in case that 10/469,795 will be maintained and Mr Hormann was instructed to proceed in such a way. Nevertheless in both cases WHD is not interested in a revival.

Furthermore please try to revive following US applications:

09/931,694 - abandoned; published as US 2001-0054901 A1 (my ref: 1.157.US) 09/423,275 - abandoned; not published (my ref: 1.159.US1) 10/619,038 - abandoned; published as US 2004-0012773 A1 (my ref: 1.159.US2) 10/469,652 - abandoned; published as US 2004-0096648 A1 (my ref: 1.259.US)

In case that you find more abandoned cases please inform me to discuss this with WHD.

In addition I confirm that your indicated information regarding Mr Karl Hormann, based upon USPTO records, are correct:

Hormann, Karl

Law Offices Of Karl Hormann

P O Box 381516

86 Sparks St

Cambridge MA US 02238

617-491-8867 (Tel.)

617-491-8877 (Fax.)

26470

Attorney

Please find attached a power of attorney according to your form which you already sent to me.

Furthermore please provide me also with a Power of Attorney to be signed by WHD according to following US patent: US 5,911,298 (08/952,405) (my ref: 1.106.US)

Best regards,

Martin

On Thursday 12/8/2005 12:46 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating that:

Martin - Thank you for confirming that you are our privity client; that you are responsible for paying our fees and disbursements.

Attached please find a power of attorney for US 5,911,298 (08/952,405) (my ref: 1.106.US) in both pdf and wpd formats.

Our billing reference relating to portfolio transfer and revival work is HENN0002.

Our billing reference relating to ongoing prosecution work is HENN0003.

We will associate separate Neifeld docket numbers with each application using the "HENN" PREFIX.

Our next step will be to gather information from the USPTO publicly available databases, to piece together the portfolio's applications into patent families, so we can assign docket numbers, and get USPTO records.

thanks, RICK

On December 8, 2005, I drafted and had sent via facsimile to 617-491-8877 a letter to Karl Hormann, Esq., stating that:

Re: PATENT PORTFOLIO OF WHD elektronische

Prufttechnik GmbH, Industriestrasse 19, 01129  
Dresden, Germany - TRANSFER OF FILES

Dear Karl:

Thank you for briefly speaking with me just now. I hope that you remain out of the hospital. Per your verbal request, I am transmitting the following information via fax to your office.

I have been instructed by my client, Martin Hennings, to take over prosecution of all U.S. patent applications and to obtain all patent files for his client WHD elektronische Prueftechnik GmbH. I understand that you currently have those files. I wish to coordinate transfer of the files with you. To that end, I would appreciate receiving (1) a list of each U.S. patent application, pending, issued, or abandoned , (2) a priority claim correspondence showing which applications claim priority, and in particular the type of priority claim as an actual continuation, division, or CIP, and (3) a docket sheet showing upcoming deadlines in each case. That will enable us to logically assign docket numbers by disclosure family and filing type.

I have also been instructed to attempt to revive what WHD believes were unintentionally abandoned applications in its portfolio. As you know, that requires a petition that contains an averment that the abandonment was in fact unintentional. In order to make that averment, I need to know facts relating to intent. Since attorney intent is a factor, and you are the attorney of record, I will need to determine whether, for the applications WHD thinks were unintentionally abandoned, whether your records and recollection agree that the abandonment was unintentional. If your records do agree, then I can in good faith make the averments required in the petitions to revive. Hence, I need to discuss with you the specifics, and obtain either evidence from your files or your written statements confirming whatever your files show and whatever you remember relevant to that

issue.

Please note, respecting petitions to revive, that time is of the essence, since failure to promptly request revival upon noting an unintentional abandonment may result in application of the unavoidable standard to any period of extended delay. Accordingly, I need to act swiftly to ascertain facts regarding the abandoned applications.

Laba Karki, Ph.D., patent agent, and Daniel Sachs, a paralegal, will be assisting me in constructing our files for WHD elektronische Prueftechnik GmbH's patent applications. Rebecca Brimmer, my admin, will probably be setting up the actual docket records in our docketing system. I hope you can facilitate their work in case they have questions for you.

To facilitate communication, please provide me your email address. My email address is rneifeld@neifeld.com.

I look forward to working with you to efficiently expedite this process.  
thanks, RICK

Very truly yours,  
Richard A. Neifeld  
President, Neifeld IP Law, PC

cc: to Martin Herrings, via email attachment, at martin.hennings@arcor.de.

On Thursday 12/8/2005 1:16 PM, I sent an email to martin.hennings@arcor.de stating that:

The noted excel file is attached. RICK

-----Original Message-----

From: Rick Neifeld

Sent: Thursday, December 08, 2005 1:15 PM

To: 'martin.hennings@arcor.de'  
Cc: Rick Neifeld; Daniel Sachs; Laba Karki; Rebecca Brimmer  
Subject: WHDPatentPortfolio \_HENN0001\_051208  
Importance: High

NEIFELD REF: HENN0001 (General matters for Martin Hennings)  
NEIFELD BILLING REF: HENN0002 (Portfolio and revival work)

Martin - I have been working with Laba on your matter since we spoke (Daniel is out of the office today; but he will assist Laba when he returns). We need to determine the extent of the portfolio, and types of priority claims even to assign our docket numbers. Laba will work on filling in the attached Excel file. It contains the information I deem necessary. He should gather the publicly available information, and the information from your prior emails, into this chart, at latest by tomorrow. Then, you can fill in any of your docket numbers we do not have.

Laba will also determine if there is an image file wrapper (IFW) for each patent application, and if so, download that document to our file system. If not, we will order a photocopy, without any references, just bare prosecution history, from the USPTO's paper records (using our contractors).

I will have our staff go ahead and file the powers of attorney we now have, and request status on each such case.

I will keep you informed on our progress.

thanks, RICK

On Thursday 12/8/2005 1:28 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating that:

Martin - We have updated the spreadsheet to help us track actions in the undocketed matters. The revised spreadsheet is attached. thanks, RICK

On Thursday 12/8/2005 1:41 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) stating that:

One further update to indicate your instructions to request revival in certain applications. RICK

On Tuesday 12/13/2005 1:40 PM, I sent an email to Laba Karki, a patent agent in my firm, stating that:

Laba - You did not fill in information in the spreadsheet based upon the attachments to Martin's email conveying partial attorney file histories to us. Go back and update the spreadsheet for the applications not publicly available, based upon Martin's attachments. See record 8, which I have started, for example. I expect this finished today. Advise when done.

thanks, RICK

On Tuesday, December 13, 2005 1:26 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de), stating that:

Martin - The attached spreadsheet shows status of our current information on your cases.

Accrued charges to date are about \$2500.

Karl Hormann failed to respond to my facsimile last week. I will have it resent now, courierred now, and also telephone him again now. I am also going to assign Neifeld docket numbers now, assuming the attached excel sheet provides me sufficient information to do so according to our numbering scheme.

Rebecca - Resend to Karl Hormann the FAX we sent last week, and also courier a copy of it to his business address.

thanks, RICK

On Tuesday 12/13/2005 1:43 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de), stating that:

I just spoke briefly with Karl Hormann. He indicated that he did get my fax, but that he was too busy to act on it. He did indicate that he would telephone me tomorrow. thanks, RICK

On Wednesday 12/14/2005 2:59 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de), stating that:

Martin - Karl Hormann has not yet called me back.

Yesterday, I started on a fact section for petitions to revive. However, I was called to home for a medical emergency in the early afternoon.

Today, I reviewed the Excel spreadsheet, made revisions, corrections, and instructed Laba to add some additional information (priority claims made in the US application as filed, and as amended). When that is done, I will be in a position to assign my firm's docket numbers.

I now continue to work on the facts section for the petitions. RICK

On Wednesday 12/14/2005 5:23 PM, I sent an email to [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de), stating that:

Martin - I desire additional factual information from you in order to complete the petitions to revive based upon unintentional abandonment. Please answer the following questions in as much detail as you think necessary to explain your understandings and information. Please note that I intend to copy in your response to my email into the facts section of the petitions, so please try to be as

accurate as you can. I suggest that you number your answers 1-4 to correspond to my questions 1-4.

1. When did you first become aware that U.S. applications assigned to WHD and that WHD did not intend to abandon were or might be abandoned?

2. Is there any explanation, such as lack of familiarity with US patent practice, or lack of communication of the abandonments from the attorney of record to WHD, explaining why WHD was not earlier aware of the abandonments? In other words, is there a reasonable excuse explaining the delay in action until November 2005?

3. What are the facts and circumstances that resulted in your or WHD becoming aware that U.S. applications assigned to WHD that WHD did not intend to abandon were or might be abandoned?

4. What action did WHD or you take at that point in time WHD or you became aware of the possible unintentional abandonment(keeping in mind that my records for this matter begin with an email from your colleague Joachim Brunnotte on 11/22/2005)?

Thanks, RICK

On 12/16/2005, I received an email from [martin.hennings@arcor.de](mailto:martin.hennings@arcor.de) responding to my questions, in which Martin Hennings stated that:

Dear Rick,

Dear Laba,

Thanks for your recent emails.

Please note that in the excel spreadsheet is a little mistake: Instead for revival of 08/894,766 I ask for revival of 09/931,694 according to my email dated 12/8/2005. The case 08/894,766 is one of those where it is not yet clear if it is abandoned or not therefore it is not yet clear if revival is desired.

According to 09/423,274 please find attached all available official

documents or copies thereof. 09/931,694 is in fact a continuation in part of 09/423,274. It was decided not to proceed with 09/423,274.

According to your questions 1 to 4 please find below my comments:

1. I was informed by the (at that time) German Representative of WHD, Patent Attorney Mr Wolfgang Heitsch, in a meeting on November 10, 2005. According to my information given by Mr Heitsch, he asked several times Mr Hormann for status information. Because Mr Hormann did not react on that request Mr Heitsch made an online inspection on the website of the USPTO. On December 2, 2005 I received the physical files from Mr Heitsch.

2. I assume that Mr Heitsch believed on information/non-information given to him by Mr Hormann and Mr Heitsch believed until November 2005 that everything is in order and all applications are not abandoned. Therefore it seems to be a lack of communication from Mr Hormann to Mr Heitsch and therefore to WHD.

3. Mr Heitsch informed WHD about the problems with Mr Hormann on November 18, 2005 as well as the unintentionally abandonment according to the information by the online register of the USPTO.

4. On November 18, 2005 in a telephone conversation with WHD I was instructed to propose a new US Representative. According to your information I informed WHD about the status of the US applications on November 24, 2005. On the same day I was instructed by WHD to revive 4 of 6 application which were unintentionally abandoned. For the other 2 applications (which were also unintentionally abandoned) WHD decided not to revive. On December 2, 2005 I received the physical files from Mr Heitsch and collect all official documents from these files. On December 7, 2005 I received the Power of Attorney for the US cases signed by WHD. As you know on December 8, 2005 I sent an Email to you regarding the revival including documents.

Furthermore please find attached a power of attorney signed by WHD according to US patent: US 5,911,298 (08/952,405) (my ref: 1.106.US)

According to the requested specifications as filed unfortunately I did not find these documents.

Best regards,

Martin

On 12/16/2005, at 2:50 PM I again called Karl Hormann via telephone and left a vm message for him. I also googled his law firm name and eventually found the form page [http://pview.findlaw.com/cmd/profileview?xsl=/xsl/lawyer\\_emailform.xsl&wld\\_id=2624779\\_1&which=email\\_addr:1](http://pview.findlaw.com/cmd/profileview?xsl=/xsl/lawyer_emailform.xsl&wld_id=2624779_1&which=email_addr:1) containing a form input for emailing Karl. In that page I typed the message:

Karl, please contact me asap regarding the WHD portfolio transfer.

Rick Neifeld, Ph.D. Patent Attorney

President

Neifeld IP Law, PC URL: [www.Neifeld.com](http://www.Neifeld.com)

StockPricePredictor.com, LLC URL: [www.PatentValuePredictor.com](http://www.PatentValuePredictor.com)

4813-B Eisenhower Avenue

Alexandria Virginia 22304

Tel: 703-415-0012

Fax: 703-415-0013

and then clicked the "Send message" button.

On 12/16/2005, I spent 1.7 hours reviewing the WHD portfolio information, and generating and sending the following to emails.

First, to Martin Hennings, I sent the following text:

NEIFELD REF: HENN0001

Dear Martin:

1. I have corrected and updated our spreadsheet, and I have also assigned my firm's new invention family numbers and corresponding Neifeld IP Law, PC docketing numbers in that spreadsheet. We are now in a position to order files from the USPTO. However, our attempt may still be frustrated due to lack of proof of our power of authority to review abandoned secret files.

2. The spreadsheet shows that we downloaded image file wrappers (IFWs) for 4 applications in which IFWs were available to the public (records 10-14 in our spreadsheet).

3. The spreadsheet shows that IFWs are not available in 9 applications (records 2-10 in our spreadsheet).

3A. However, of those 9 application, PAIR indicates that the following applications are publicly available to the general public for copying from the USPTO.

09/931,694

09/423,274

09/423,275

08/952,405 now USP 5911298

It will cost roughly \$500 to obtain a copy of each application, including my firm's charges. Based upon your prior authorization, and since Mr. Hormann is not responsive, we will not go ahead and order these files.

3b. PAIR records do not exist for the following 5 applications indicating that they are not available to the public.

10/110,600

09/719,881

09/485,750

09/485,734

08/894,766

Copies of these files can only be obtained when proof of authority from the legal owner exists. Our current power from WHD may or may not be sufficient for the USPTO to provide us a copies of the files. However, we will try to order them now and see what happens.

It will cost roughly \$500 to obtain a copy of each application, including my firm's charges. Based upon your prior authorization, and since Mr. Hormann is not responsive, we will not go ahead and order these files.

5. Our cost for docketing transfer applications, as specified on our fee sheet, is \$250 per application. We will now go ahead and docket in all of the applications, per your prior instructions to take over responsibility for this portfolio.

Please note that, with all of those charges, WHD's costs will certainly exceed \$10. Moreover, since this is year end, and WHD is a new client, I will issue an invoice shortly for services to date, to clean up our firm books.

6. Our next step will be obtaining whatever information we still need to petition to revive specific to each case. Hormann clearly is not cooperating, so I expect no more information from him, and we have to act promptly in any case.

Moreover, any petition to revive must include a response to the outstanding office action to which the application failed to respond which resulted in the abandonment, and the fees required for the petitions to revival, applicable government extension fees, and claims fees and terminal disclaimer fees associated with any response. Hence, we need a copy of any such office action in each case. I will review our client's file (WHD's files and the PAIR files) next, to see if we can ascertain if we have the outstanding office action in each case, and what else we need to do in each case viz a petition to revive. I will keep you informed.

Second, to my staff:

Daniel and Rebecca - Please do not report this using LogAndAuditTrack.

1. Docket in the 13 applications identified in records 2-14 in the spreadsheet using the docket numbers I assigned in column AA in:

Y:\Clients\Hennings\HENN0001\WHDPortfolio\PortfolioSummary\_051208.xls

2. Place corresponding family folders and in them docket number folders in  
Y:\Clients\Hennings\HENN0010 TO HENN0020

Laba - Order the files specified below from Burt at PatentGateway via email burt@patentgateway.com.

On 12/19/2005, I noted that Laba Karki had ordered copies of USPTO official files from a contractor, PatentGateway, and exchanged a few emails with Dr. Karki on that issue.

On 12/19/2005, I also began to draft from a generic petition listing relief and facts common to all application for which WHD had requested revival, facts specific to each such case.

On 12/21/2005, based upon the information I and Dr. Karki had gathered, I spent .8 hours setting up application docket records in our firm docketing system for the WHD applications.

On 12/22/2005, I spent 3.0 hours docketing in the WHD applications based upon available information.

I was away on vacation over the Christmas holiday.

On 12/28/2005, I received an email from Dr. Karki reporting that the USPTO clerks had reported to him that WHD applications now docketed by our firm as HENN0010UPCT-US; HENN0012UPCT-US; HENN0013UPCT-US; HENN0014UPCT-US; AND HENN0017UPCT-US were also abandoned.

I should note that Dr. Karki was also spending considerable time determining the status and obtaining files (via contract service or directly) from the USPTO during the time period from when my firm was first engaged on behalf of WHD.

On 12/29/2005, I continued work on this petition. I also placed yet another telephone call to Karl Hormann, at 1-617-491-8867, and left another voice message.

37 CF 1.137 read in pertinent part:

§ 1.137 Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(b) Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph **to revive an abandoned application**, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) **The reply required to the outstanding Office action or notice**, unless previously filed;

(2) **The petition fee as set forth in § 1.17(m);**

(3) **A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.** The Director may require additional information where there is a question whether the delay was unintentional; and

(4) **Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.**

(c) Reply. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(d) Terminal disclaimer.

(1) Any petition to revive patent. A grantable petition pursuant to this

paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(c) Reply. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(d) Terminal disclaimer.

(1) Any petition to revive pursuant to this section in a **design application** must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a **utility or plant application filed before June 8, 1995**, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c) from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph

(d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, to reissue applications, or to reexamination proceedings.

(e) Request for reconsideration. Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated reexamination proceeding, or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

(1) The provisions of § 1.136 for an abandoned application or lapsed patent;

(2) The provisions of § 1.550(c) for a terminated ex parte reexamination proceeding filed under § 1.510; or

(3) The provisions of § 1.956 for a terminated inter partes reexamination proceeding filed under § 1.913.

On 1/5/2005, I reviewed a draft response prepared under my supervision by patent agent Laba Karki and a printout of the file history. I noted that the application went abandoned for the prior counsel's failure to provide drawings required in a notice of allowability when the attorney filed the issue fee transmittal and issue fee.

### **III. Statement of the Reasons Why the Relief Requested Should be Granted**

#### **A. Requirements to grant the petition**

**The entire delay in filing the required reply from the due date for the reply until the filing of this grantable petition was unintentional.**

**This petition is accompanied by a reply to the outstanding Office action or notice.**

**This petition is accompanied by the fee set forth in § 1.17(m) (\$1500 dollars for large entities and \$750 for small entities according to the USPTO web site list of fees as of 12/29/2005 posted at**

**<http://www.uspto.gov/web/offices/ac/qs/ope/fee2005oct01.htm>.**

**This application was filed after 12/8/2005, and it is a utility application. Therefore, no terminal disclaimer is required to grant this petition.**

The foregoing shows the regulatory requirements for granting a petition to revive are satisfied.

#### **B. Diligence upon Discovery and lack of Intent to Abandon**

WHD elektronische Prueftechnik GmbH (WHD) indicated to me, via its local German patent attorney, Martin Hennings, that it had no intention of abandoning this application. Hence, the abandonment was unintentional. The email exchanges between myself and Martin Hennings show that WHD did not know that this application was in fact abandoned until late in November 2005, when WHD's prior German patent attorney check the USPTO web site for status of WHD U.S. patent applications.

The email exchanges between myself and Martin Hennings noted above in the facts section show that WHD took *prompt* action, via its current German patent attorney, Martin Hennings, to determine the facts and attempt to revive the applications. They also show that my firm and I took prompt action to ascertain the facts necessary to prepare this petition; determining the scope and content of the WHD portfolio, inquiring on the intent issue with both WHD and WHD's prior U.S. counsel. WHD has been responsive. WHD's prior US counsel, Mr. Hormann,

has not yet been responsive. As of 12/16/2005, I had spoken with Mr. Hormann twice, and sent him a facsimile. Since that time, I had placed several more telephone calls (3 to 5) and left voice messages each time, none of which were returned. In my first conversation, Mr. Hormann indicated to me that he had just left a hospital, and would call me back the next day. About 2 days later, I called Mr. Hormann again, and he told me at that time that he had received my facsimile, but that he was very busy and would telephone me the following day. As of 12/29/2005, despite my repeated telephone calls and voice messages, I have not received further communications from Mr. Hormann.

My email exchanges show that, on November 22, 2005, I provided information necessary for Martin to counsel WHD and request instructions.

Martin responded with his clients instructions on December 8, 2005, along with image copies attached to his email, of all records he could obtain regarding WHD's U.S. patent applications, instructing me to petition for revival of this and other applications. Those records were clearly incomplete.

From that time on, I acted diligently to acquire the facts necessary to make this petition, including ascertaining to my satisfaction that there was no evidence of intentional abandonment. I reviewed the partial files Mr. Henning sent me from WHD's records, reviewed the data publicly available from the USPTO via its PAIR, USP, and PGP data servers, had the available IFWs downloaded, repeatedly contacted Mr. Hormann requesting his help and factual information.

Lacking attorney files, determining status of an application (pending, abandoned, or issued) and how to respond on the merits to any outstanding actions is a difficult if not impossible process. For example, as part of that process, Laba Karki and I generated a spreadsheet of the formal data we could gather for the WHD application that, as of about 12/16/2005, contained 260 cells (13 identified applications and 20 cells of data for each application's record) attempting to determine status and relationships between identified WHD applications.

As of this time, I do not know for certain that status of many of the applications, or whether additional applications filed by Mr. Hormann on behalf of WHD exist. During the course of my review of the formal data, I did identify at least one instance in which PAIR showed

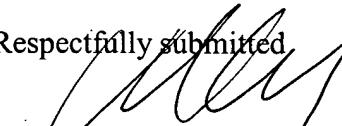
that Mr. Hormann assigned the same attorney reference to two different applications.

In any event, I did satisfy myself, upon investigation, that WHD had no intent to abandon this application. Accordingly, this petition to revive should be granted. Further, my interactions with Mr. Hormann objectively show (via his lack of communication) that he is incompetent, thereby implying a lack of intent on his part. Moreover, if Mr. Hormann did have an intent to abandon this WHD application, that would have been beyond his representative authority since it was contrary to his client's instructions. Hence, I am satisfied that there was no intent upon any party to abandon this application.

Mr. Hormann submitted the issue fee transmittal, but he failed to submit therewith formal drawings. The fact that Mr. Hormann paid the issue fee is objective indication that he had no intent to abandon this application. His failure to file formal drawing was clearly a clerical error, not an intentional error. Accordingly, this is further evidence of lack of intent on Mr. Hormann and WHD's part to abandon. Hence, the abandonment was unintentional.

Respectfully submitted,

1/5/06

  
Richard Neifeld

Registration No: 35,299

Attorney of record

RAN

January 5, 2006 (4:07pm)

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PCT-US\_051229.wpd